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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,510	06/29/2001	Brian Rasmussen	SUN-P6236	8236

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LABAZE, EDWYN

ART UNIT	PAPER NUMBER
	2876

DATE MAILED: 06/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/895,510	RASMUSSEN ET AL.
	Examiner	Art Unit
	EDWYN LABAZE	2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 March 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-16 and 23-25 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of amendments filed on 3/24/2003.
2. Claims 1-16 and 23-25 are presented for examination.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6, 9-13 are rejected under 35 U.S.C. 102(b) as being unpatented by Muftic (U.S. 5,943,423).

Re claims 1 and 9: Muftic teaches smart token system for secure electronic transactions and identification, comprising method of receiving identifying information for a non-activated (where the domain on the card is not already opened) smart card 360 (col.4, lines 1-67 and col.5, lines 1-22); receiving manual authentication information (as broadly interpreted by the examiner as either a PIN number and/or a digital/manual signature) for user to whom the non-activated smart card 360 has been issued (col.3, lines 60+); authenticating/verifying the user and the non-activated smart using the identifying information and the manual information/digital signature (col.4, lines 1-16; col.5, lines 43+); obtaining a public key (through the public digital signature key DSK 430) from the non-activated smart card 360 (col.3, lines 56+; col.5, lines 23-67 and col.10, lines 12+); and issuing a digital certificate/seal that is generated using the public key, (col. 5, lines 55-67; col.16, lines 1-67) wherein the non-activated smart card is activated upon

receiving the digital certificate (col.10, lines 30-67), and further includes method of sending identifying information read from a non-activated smart card (col.5, lines 33+); sending manual authentication information (See Fig. # 18 of Muftic; col.15, lines 44+); sending public key to the administrator (col.5, lines 36+); generating a public key using the non-activated smart card (See Fig. # 19 of Muftic and col.15, lines 50+).

Re claims 2 and 10: Muftic teaches a system and method, wherein the manual authentication information comprises a user identifier 415, 420 (or a PIN number identifying the user; col.10, lines 1+) and a password (col.5, lines 25+; col.12, lines 60+ and col.15, lines 27-50).

Re claims 3 and 11: Muftic teaches a system and method, further comprising obtaining the digital certificate from a certificate authority (col.10, lines 34+).

Re claims 4 and 12: Muftic discloses a system and method, wherein the smart card 360 is connected to a workstation (See Fig. # 2 of Muftic).

Re claims 5, and 13: Muftic teaches a system and method, wherein the digital certificate is stored in at least one of the activated smart card 360 and a workstation (col.15, lines 42-67 and col.16, lines 1+).

Re claim 6: Muftic discloses a system and method, further comprising receiving a login request that is initiated when the activated smart card is connected to a workstation (See Figs. # 17 & 18 of Muftic and col.5, lines 23+; col.10, lines 63+; col.12, lines 60+; col.15, lines 27+); authenticating/verifying the activated smart card using the digital certificate (col.15, lines 51+ and col.20, lines 35+); and if authenticated, permitted a login to a computer resource (col.15, lines 27-50).

Claim Rejections - 35 USC § 103

5: The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7-8, 14-15, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muftic (U.S. 5,943,423) in view of Boroditsky et al. (U.S. 6,332,192).

The teachings of Muftic have been discussed above.

Re claims 7and 15: Muftic fails to show a method of removing the smart card from the workstation/network after login is authenticated and the digital certificate is sent.

Boroditsky et al. discloses a method, wherein the authenticating further connecting the smart card to a workstation or computer, removing the smart card from the workstation after the authenticating (col.13, lines 1-32).

In view of Boroditsky et al.'s teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teaching of Muftic a system allowing the user to remove the digital identity or smart card from the workstation after the authenticating to prevent thief or access to stolen property by leaving or forgetting the digital identity or smart card into the terminal, which can be redeemed by anyone and would assure the security of personal information being in the wrong hands.

The teachings of Muftic have been discussed above.

Re claims 8, 14, 16, and 23-25: Muftic fails to show a method of determining that the digital certificate or smart card has not been revoked or disallowed.

Boroditsky et al. teaches a method, wherein the authenticating further comprises determining that the digital certificate has not been revoked or disallowed (col. 11, lines 51+).

In view of Boroditsky et al.'s teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to include a method of determining that the digital certificate has been revoked or disallowed into the teaching of Muftic in order to keep the user informed of the validity of the certificate. In addition, such modification would require a subroutine in the software program, which first check the domain/key on the card in comparison with a list of revoked/disallowed accounts stored in the database and if matched would end all process and inform the user that the card/digital certificate has been revoked or to see a service representative. Furthermore, if no match were found, the network/workstation would allow the user to login or have access to the computer resource by verifying/authenticating the smart card/digital identity, and also permit the user to remove the card or digital identity after authenticating the smart card or digital certificate.

Re claim 24: See the discussions as set forth in claim 7 above.

Re claim 25: Muftic teaches a system and method, wherein the digital certificate is stored in at least one of the activated smart card 360 and a workstation (col. 15, lines 42-67 and col. 16, lines 1+).

Response to Arguments

7. Applicant's arguments with respect to claims 1-16 and 23-25 filed on 3/24/2003 have fully considered but are moot in view of the new ground(s) of rejections.

Re claims 6-8, and 14-16: The appellant argues that, the prior art cited by the examiner, Khan et al. (U.S. 6,401,206) in combination with Boroditsky et al. (U.S. 6,332,192) does not anticipate the claimed invention (see pages 8-11 of applicant's arguments). Furthermore, the applicant acknowledges that Boroditsky et al. teaches "method of authenticating a user" (see page 8, 4th paragraph of applicant's response).

The examiner respectfully agrees with the applicant's arguments that the combination of Khan et al. and Boroditsky et al. does not render anticipate claims 6, 14, 17-19 and 21 of the claimed invention, only because the teachings of Khan et al. lack the limitations of "method of receiving information for a non-activated smart card". The new ground of rejection, Muftic (U.S. 5,943,423) does teach "method of receiving information for a non-activated smart card" (see Final Office Action, paper # 4) and the examiner believes that the combination of Muftic and Boroditsky et al. does anticipate or render obvious the limitations of claims 7-8, 14-16, and 23-25 as amended by the applicant.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gasser et al. (U.S. 5,220,604) discloses method for performing group exclusion in hierarchical group structures.

Naccache (U.S. 5,910,989) teaches method for the generation of electronic signatures, in particular for smart cards.

Craig et al. (U.S. 6,260,111) teaches system and method for network power management incorporating user identity and preferences via a power managed smart card.

Kahn et al. (U.S. 6,401,206) discloses method and apparatus for binding electronic impressions made by digital identities to documents.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (703) 305-5437. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Art Unit: 2876

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

el
Edwyn Labaze
Patent Examiner
Art Unit 2876
June 2, 2003

Diane I. Lee
DIANE I. LEE
PRIMARY EXAMINER